United States Court of Appeals

for the Second Circuit

APPELLANT'S REPLY BRIEF

76-7563

United States Court of Appeals

FOR THE SECOND CIRCUIT

DAVID COHN,

Plaintiff-Appellant,

against

COLECO INDUSTRIES, INC.,

Defendant-Appellee.

APPEAL FROM AN ORDER AND JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

REPLY BRIEF OF PLAINTIFF-APPELLANT

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I THE MEMORANDUM AND ORDER AND JUDGMENT

A THERE ARE NO FINDINGS OF FACT

In its Brief in this Appeal, Coleco relies heavily on the Memorandum and Order of the Court below. On page 6 (first paragraph) of its Brief, Coleco restates the Court's vague statements as findings. The fact of the matter is that the Court made no findings of fact in its Memorandum and Order. And Coleco did not propose any findings of fact for the Court to adopt in the proposed Judgment which Coleco submitted.

If Coleco had proposed findings of fact for the Court below to adopt, and the Court had adopted them, this Court could scrutinize them closely. In Burgess & Associates, Inc. v. Klingensmith, 487 F 2d 321 (9th Cir. 1973), the Court stated:

> The district court decision was embodied in a conclusionary memorandum of decision and in lengthy findings of fact and conclusions of law drafted by counsel for Burgess and adopted by the court. The court did not write an opinion. While it may be permissable for a judge to adopt findings proposed by counsel in complex patent cases, ... an appellate court will scrutinize them more carefully than findings which are the product of the judge's own independent thought and research....

It is even more appropriate here to closely scrutinize what Coleco belatedly proposes as findings of fact in Section III B of its Brief, which were never reviewed or adopted by the Court below.

A review of the Memorandum and Order shows that the statements made by the Court in ruling for Coleco are unfortunately vague. For example:

* Which are the narrowing amendments the Court refers to?
* If there are narrowing amendments, why were they made and are they relevant and material to a Conclusion of Law that the Doctrine of File Wrapper Estoppel applies?
* In what way is the coverage of the patent restricted?
* Is the restriction relevant to the Court's Conclusion that the Doctrine of File Wrapper estoppel applies?
* Is the Court's Conclusion that the Doctrine of Equivalents cannot be used to extend the scope of protection properly based?
* Which are the "<u>certain</u> structural limitations" as to which there is "no dispute" that the Coleco game does not contain them?

Cohn has maintained and still maintains that the Coleco game contains the same or covered equivalent elements acting in the same manner to achieve the same result as the game covered by his patent. Cohn vigorously disputes any conten-

tion to the contrary. Cohn respectfully submits that the Court below is apparently following unfounded statements of Coleco in the statement about no disputes.

On the positive side of its decision, however, the Court did recognize that the Cohn patent in suit might be entitled to some protection of equivalents for some elements of the claim. (Appendix at page 252)

The Court below cites one prior decision, Pittway Corp. v. Trine Mfg. Corp., 183 USPQ 675 (SDNY 1974), as grounds for its Memorandum and Order. In contrast to the Pittway decision, in which that Court described in detail the specific limitation inserted by amendment to overcome prior art, which it found to be present in Pittway's patent and not in Trine's accused product, the decision being appealed from here provides no findings of fact which allow one to see the Court's reasoning and whether summary judgment may validly be granted.

B SUMMARY JUDGMENT IS NOT APPLICABLE WHERE THERE ARE GENUINE ISSUES OF FACT

Coleco argues that summary judgment should be granted. Cohn maintains that it is inapplicable. In Heyman v. Commerce and Industry Insurance Company, 524 F 2d 1317, 1318 (1975), this Court stated:

> Although the basic principles for granting summary judgment (Fed. R. Civ. P. 56 (c) cited) are well-established, the frequent recurrence of cases in

which granting it is inappropriate persuades us that these tenets bear repetition."

The Court continued:

> But the "fundamental maxim" remains that on a motion for summary judgment the court cannot try issues of fact; it can only determine whether there are issues to be tried. ... Moreover, when the court considers a motion for summary judgment, it must resolve all reasonable inferences in favor of the party against whom summary judgment is sought, ... with the burden on the moving party to demonstrate the absence of any material factual issue genuinely in dispute, ... This rule is clearly appropriate, given the nature of summary judgment. This procedural weapon is a drastic device since its prophylactic function, when exercised, cuts off a party's right to present his case to the jury.

In the Heyman case, the meaning of one simple contract term, "new building," was at issue, and the Court reversed summary judgment. Here, the Court is asked to consider many technical terms in a complex patent case. It is respectfully submitted that here too summary judgment sould be reversed.

II THE PROSECUTION OF COHN U.S. PATENT 3,019,020

In Coleco's Brief and its restatement of the Memorandum and Order of the Court below, one is left with the inference that the claims of the Cohn patent in suit were only amended to overcome prior art, that all amendments were relevant and material to that purpose, and that the Coleco game does not in any aspect literally or even in equivalents infringe the claims of the Cohn patent in suit.

Cohn vigorously denies this.

A review of the file history of the Cohn patent indicates two basic threads in the prosecution. One thread is the Applicant's attempts to clarify the language of the claims, and the other is the Examiner's objection to the claims based on certain prior art references, particularly the Lloyd and Igou references which appear in the Appendix at pages 130 and 137 respectively.

Amendments were made to clarify the wording of the claims, remedy indefiniteness by describing a functioning device in the claims in view of the best mode described in the application, and to distinguish over the prior art.

In accordance with 35 U.S.C. 112, Cohn had described the best mode for his game in the specification of the patent in suit. It was described the way he manufactured it.

A reading of claim 4 as filed will show that it is somewhat indefinite. Therefore, Cohn's attorney clarified

the language in terms of the best mode in the specification. Claim 17 was submitted for the Examiner's consideration with the belief that the claims were in proper order and distinguished over the references (Appendix at page 74 and 79).

In its Brief (page 11, second paragraph), Coleco states that all the listed features are "additional limitations which had not appeared in original claim 4." A comparison of claim 17 with claim 4 will show that the changes made were clarifications of indefinite wording of items contained in or implicit in claim 4 or descriptions of the preferred embodiment to provide further definiteness to the claim. If Coleco will study Cohn's answer to Request for Admission 31 on page 110 of the Appendix, it will be seen that Cohn has only stated that the claim 17 generally contained amendments indicated in a to e of Request 31. Nothing is admitted as to the amendments being limitations or as being for the purpose of distinguishing over the prior art.

Yet the attempt at clarification was unsuccessful, for the Examiner found the last seven lines of claim 17 to be functional. More clarification was required. Later claim 18 was substituted for claim 17, Cohn's attorney stating that the application was to be "corrected" and it was "believed to be corrected in accordance with the thoughts of the Examiner, as the result of the interview...." (appendix at pages 89 and 92 respectively.) On page 14 of its Brief Coleco states that Cohn admits claim 18 added the material given there for the purpose of distinguishing over the prior

art, citing Admissions Nos. 38 and 39. A reading of the Requests and the Admissions shows that Cohn made no such admission. Cohn's attorney also spoke of correcting in inserting claim 19 (Appendix at page 94).

It is, of course, a question of fact as to which amendments were submitted to clarify the wording of the claims. There should be no application of the Doctrine of File Wrapper Estoppel, however, where the purpose of amendment was for clarification. See Eimco Corp. v. Peterson Filters & Engineering Co., 406 F 2d 431, 438 (10 Cir. 1968).

In addition, in accordance with the third paragraph of 35 U.S.C. 112 "means" elements in the claims should be "construed to cover corresponding structure, material, or acts described in the specification and equivalents thereof."

It is probably informative at this point to briefly review the Lloyd and Igou references. They are both directed to large scale games and rely on the use of moveable locator means or templates to hold the pins in order to replace the pins a the proper positions on the alley. In contrast, the toy game of the Cohn patent in suit uses a stationary guide plate having appropriately spaced holes through which the strings attached to the bowling pins pass. This feature was added in claim 18 in the next to last amendment. It is submitted that that amendment provided the claims with a patentable distinction over the prior art. It was that amendment which caused the Examiner to allow the application.

Previous amendments submitted by Cohn's attorneys to clarify the claim wording did not have this patentable distinction and therefore the claims were not allowed by the Examiner as patentable over the art.

It will be noted that the Coleco game contains this same guide plate, although Coleco calls it a "cone insert." It functions in the exact same way as the Cohn guide plate of his patent.

It should again be noted that Cohn's attorneys were unsuccessful in gaining allowance until the insertion of the guide plate. Consequently, any arguments made prior to that time by Cohn's attorneys in an attempt to gain allowance of the application were unsuccessful, and the Examiner did not rely on them. Quite to the contrary, he finally rejected the application. Therefore, Capri Jewelry v. Hattie Carnegie Jewelry enterpr., 539 F 2d 846, 851 2 Cir. 1976) is believed not to be in point because there the Applicant's attorneys convinced the Patent Office with their arguments.

III THE COLECO GAME - PLAINTIFF'S EXHIBIT B

In its Brief, Coleco shows that it misunderstands and it therefore misstates the purpose for Cohn's introducing Plaintiff's Exhibit B, photographs of which appear in the Appendix at pages 190 to 207.

Cohn introduced the game of Exhibit B to show that the Coleco game is the game of the Cohn patent in suit. The game of Exhibit B, the Coleco game, is discussed in the Slinger Affidavit in the Appendix beginning at page 183.

In contrast to the essential simplicity of the Cohn game, described in the Cohn patent in suit, and consequently the broad scope of coverage that should be accorded to the Cohn patent, the Coleco game contains in many instances several parts to accomplish what in the preferred embodiment of the Cohn patent is accomplished in one part.

It is well settled law that one does not avoid infringement by making two or more parts accomplish the function of one part. Eastern Rotorcraft Corp. v. U.S. 397 F 2d 978 (Ct.Claims 1968).

Coleco maintains and argues that six features mentioned in the claims of the Cohn patent in suit are not present in the Coleco game:

A BASE PLATE

The purpose of the base plate in the Cohn patent as it is in the Coleco game, is to provide a flat playing surface on which the pins can be magnetically attracted in the appropriate spots. In the Cohn patent the magnetic material in the base plate may be metal as the claims have read from filing. Coleco put ten magnets in the extensive playing surface of its base plate. Magnets are magnetic material, of course.

B FLANGES

Like the Cohn game, Coleco's is a unitary device. It too has integral flanges as further described on page 6 of the Cohn Brief.

C U-SHAPED FRAME

Again Coleco argues all the additional items they have added to their U-shaped frame, but as pointed out above, it is well-settled law that adding elements does not avoid infringement. The fact remains that they have vertical side pieces and a horizontal cross piece, and the cross piece is in spaced relation to the base plate so that the guide plate can be fastened to it and extend over the base plate in proper location to set the pins. As described in the Cohn patent, the bottom legs of the U-shaped frame are secured to the flanges. Because Coleco has embellished the Cohn game with another element, the ball return chute at the rear of the game, Coleco extends the flanges and secures the U-shaped frame to the extended flanges.

D SUPPORTING MEMBER

Coleco argues a distinction about the position of the support member of its game as being below the guide plate. However, that again is a matter of the bends in the strings, an additional element, which does not avoid infringement.

E SPRING MEANS BETWEEN GUIDE PLATE AND SUPPORT MEMBER

This is fairly obvious and visible to all, but Coleco argues that if one follows the U-turn of the strings that the support brace is biased toward the base rather than away

from the base. A very interesting point because following that logic the support member would end above the guide plate.

F ELASTIC STRING

Coleco uses a combination of a string and a spring as its elastic string. The spring segment imparts elasticity to the string. This is easily seen if one holds the end of the spring fixed and pulls on the end of the string: it is elastic.

It was because of the problems that could be envisioned for the Court that Cohn introduced his Exhibit B so that the parts of the Coleco game that are usually hidden in housings could be exposed to view by the Court and so that the parts of the Coleco game could be compared to the corresponding parts of the preferred embodiment of the Cohn patent on one unit.

IV THE AFFIDAVIT OF MR. SLINGER, COHN'S EXPERT

The Affidavit of Dr. Tetstone and the Arguments of Coleco dwell on the multiplicity of details in the Coleco game, thereby obscuring the fact that the Coleco game is covered by the Cohn patent in suit.

To aid the Court in seeing this essential similarity, Cohn introduced the Affidavit of Mr. Slinger, a mechanical engineer. He is a man used to dealing with mechanical concepts and hardware and familiar with patents because he

himself is the patentee of several patents. After reading the Cohn patent in suit and the Coleco patent and then inspecting Exhibit B, he found that the only differences between the Cohn patent in suit and the Coleco game were the extras Coleco had hung on Cohn's game.

Coleco in one of several attempts to put words in the mouth of Cohn or his expert, Mr. Slinger, states that Mr. Slinger "admits" in his affidavit that the "Coleco game does not have the specific elements of structure defined by the Cohn patent claims." Mr. Slinger made no such statement, either in haec verba or by inference. Throughout his affidavit, Mr. Slinger maintains that the Coleco game is the Cohn game of the patent in suit, although the Coleco game is disguised and its working hidden by housings.

V CONCLUSION

It has been shown that there are no findings of fact on which to predicate summary judgment of non-infringement in this action. In addition, it has been shown that there are material issues of genuine fact as to reason for and effect of actions during prosecution of the Cohn patent application so that the decision of the Court below based on File Wrapper Estoppel should not be sustained. In any event it is established policy and equitable to resolve all doubts concerning reversal of the judgment in favor of the Appellant (Cohn).

On reason and authority, therefore, the final Order and Summary Judgment of the District Court should be reversed by ordering that the Complaint be reinstated and that the case be remanded for trial on the merits.

Respectfully submitted,

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